

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 10 2001

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

*PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES* **Ex parte** DAVID D. MURESAN and DAVID MURESAN

Appeal No. 1998-3357
Application No. 08/653,425

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

This is a decision on the appellants' request, (Paper No. 17), that we reconsider our decision in Ex parte Muresan, No. 1998-3357 (Bd.Pat.App. & Int. July 16, 2001), which affirmed the rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,371,516 (Toyoda). Rather than reiterate their arguments in toto, we refer the reader to the request for the details thereof. After reconsidering our original decision in light of the arguments, we are not persuaded of error therein. Therefore, we deny the appellants' request to make any changes.

At the outset, we emphasize that "the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. ...

[T]he name of the game is the claim" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). With this principle in mind, we address the appellants' three arguments.

First, the appellants argue, "[m]y mouse with two contacts inside of the mouse and the table contact as the third, is different than Toyoda's Pen with three contact inside of the mouse (20x, 20y and wheel 52) and the table contact as the fourth contact." (Req. Reh'g at 1.) As we explained in our original decision, "[g]iving the claim its broadest reasonable interpretation, the limitations require a ball in contact with at least X- and Y-coordinate shafts. Because the claim uses the transitional term 'comprising,' however, it does not preclude additional contacts." Muresan, at 6.

Second, the appellants argue, "[m]y mouse has the case sliding on the table In my mouse the table contact and the x and y contacts will create a triangle to support the ball. In Toyoda's pen the contact 20x, 20y and the wheel 52 will create the necessary triangle to support the ball." (Req. Reh'g at 1.) As we noted in our original decision, "'limitations are not to be read into the claims from the specification.'" Muresan, at 5 (quoting In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993)).

Here, as we explained in our original decision, "claim 1 specifies [only] the following limitations: '[t]he Computer Mouse comprising: a magnet which attracts the rubber magnetic core ball against the X and Y coordinate shafts.'" Muresan, at 6. The claim recites neither "the case sliding on the table" nor that "the table contact and the x and y contacts will create a triangle to support the ball" as argued by the appellants. Accordingly, we are not persuaded by the argument.

Third, and last, the appellants argue, "[m]y invention has another advantage, which could not be found in any other mouses, that is: possibility [sic] to place the contacts x and y in the

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middle plane of the ball, and so the friction is minimum." (Req. Reh'g at 1.) Claim 1, however, fails to recite "plac[ing] the contacts x and y in the middle plane of the ball ... so the friction is minimum" as argued by the appellants. Accordingly, we are not persuaded by the argument.

Any other arguments in the request for rehearing merely repeat those made in the appeal brief and duly considered by the Board in rendering its decision. Arguments not made in the brief are neither before us nor at issue but are considered waived.

We have granted the appellants' request to the extent that we have reconsidered our original decision, but we deny the request with respect to making any changes therein.

No period for taking subsequent action concerning this appeal may be extended under 37 C.F.R. § 1.136(a).

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DENIED

Lee E. Barrett
LEE E. BARRETT

LEE E. BARRETT
Administrative Patent Judge


MAURICE LEONARD BARRY
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

Stuart S. Levy
STUART S. LEVY
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